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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/745,730	12/26/2000	Yoshikazu Kobayashi	369252/99	1971

30743 7590 06/07/2004

WHITHAM, CURTIS & CHRISTOFFERSON, P.C.
11491 SUNSET HILLS ROAD
SUITE 340
RESTON, VA 20190

EXAMINER

SCHEIBEL, ROBERT C

ART UNIT	PAPER NUMBER
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2666

DATE MAILED: 06/07/2004

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/745,730

Applicant(s)

KOBAYASHI, YOSHIKAZU

Examiner

Robert C. Scheibel

Art Unit

2666

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2 and 3 is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 1 and 4-7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: "100@soho-ip.abc.co.jp" on line 14 of page 7 should be "101@soho-ip.abc.co.jp".

Appropriate correction is required.

Claim Objections

2. Claims **1 and 4-7** are objected to because of the following informalities:
 - In all of these claims, the limitation "the telephone set" is improper as it is referring to a particular telephone set of the plurality stated in the preamble. This objection can be overcome by changing the wording of this limitation in each instance to "one of the telephone sets" or something equivalent. This limitation occurs in lines 3, 6, 9, and 12 of claim 1, lines 4, 9-10, 12, and 13-14 of claim 4 and lines 2-3 of claim 7.
 - Claims 5-7 have the phrase "a telephone controller according to claim 4" in the preamble. However, claim 4 is drawn to "a telephone communication system". Therefore, claims 5-7 should be changed accordingly to be consistent. (The preamble should start with "a telephone communication system according to claim 4 wherein the telephone controller".)

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- In claims 1 and 4, the phrase "the ID" in lines 5 and 9, respectively, should be changed to "an ID".
- In claims 1 and 4, the phrase "the extension" in lines 5 and 9, respectively, should be changed to "an extension".

Appropriate correction is required.

Allowable Subject Matter

3. Claims **1-7** are allowable over the prior art if the formal matters indicated above are corrected.

4. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

5. The following is a statement of reasons for the indication of allowable subject matter: U.S. Patent 6,614,774 to Wang discloses all the limitations of claims 1 and 4 with the exception of the following: generating the extension of the telephone set, storing the extension, and notifying the telephone set of the extension. U.S. Patent 6,154,465 to Pickett discloses a method for dynamically allocating extensions to telephones in a PBX system (see line 14 of column 25 through line 17 of column 26). However, there is no reasonable motivation to combine this teaching of Pickett to Wang. Wang is a wireless system allocating visiting IP addresses to roaming users for data service; there would be no reason to allocate these users a telephone extension. Further, U.S. Patent 6,539,077 to Ranalli et al discloses a means of translating a

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telephone number to an IP address, thus associating a telephone number to an IP address. However, Ranalli does not teach allocating these telephone numbers to users based on a request from the user; rather, Ranalli teaches a method of determining the destination IP address of a user given the destination's telephone number. In view of the art of record, these claims contain allowable subject matter as described above.

Conclusion

6. This application is in condition for allowance except for the following formal matters:

- the specification has been objected to as indicated above;
- claims 1, and 4-7 have been objected to as indicated above.

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent 6,614,774 to Wang discloses a method for allocating IP addresses to users very similar to that claimed by this invention (see above for more detail). U.S. Patent 6,154,465 to Pickett discloses a method for dynamically allocating extensions to telephones in a PBX system. U.S. Patent 6,539,077 to Ranalli et al discloses a means of translating a telephone number to an IP address. U.S. Patent

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6,128,664 to Yanagidate et al discloses a method of network address translation which is similar to the address translation discussed in the specification. U.S. Patent 6,731,642 to Borella et al and U.S. 6,496,867 to Beser et al both teach methods for selecting IP addresses from a pool of addresses for use in a particular session. However, neither of them generates these IP addresses in response to a request from the telephone set as set forth in the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert C. Scheibel whose telephone number is 703-305-9062. The examiner can normally be reached on 6:30-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Seema S. Rao can be reached on 703-308-5463. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RCS 6-1-04
Robert C. Scheibel
Examiner
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